

## REMARKS

### Rejection Requirement

Applicants confirm the Examiner's indication of a telephonic election to claims 1 to 8, and 19. Applicants restate the request for rejoinder of the appropriate withdrawn claims once the above claims are found allowable.

### Objection to the Specification

The Examiner objected to the Specification because "the abstract as written contains two paragraphs." Applicants submit that the amendment to the Abstract herein overcomes this objection and respectfully request withdrawal of the objection.

### In the Claims

Upon entry of the foregoing amendment, claims 1, 2, 5 to 8 and 19 are currently pending. Claims 3 and 4 are cancelled herein. Claims 9 to 18 are withdrawn herein. Applicants submit that any rejections or objections directed to the cancelled or withdrawn claims are thereby rendered moot.

### Claim Rejections – 35 USC § 103

Claims 1 to 8 and 19 were rejected as being "unpatentable over Corbau et al. (WO02/004424), in view of Jones et al. (WO02/085860)." Applicants respectfully assert that this rejection is improper and request withdrawal of the rejection in light of the following arguments.

The Jones et al. document (the '860 Publication) is not available as a proper reference under §103. The instant application claims priority to a foreign application, UK0221477.3, which was filed on September 16, 2002. This priority claim is acknowledged by the Examiner in the December 8, 2005, Office Action (page 2, "Priority"). The '860 publication was published on October 31, 2002, which is after the September 16, 2002 priority filing date of the instant application. Therefore, Applicants respectfully submit that the '860 publication should not be considered in an assertion of obviousness by the Examiner.

Since the '860 publication is not available as a §103 reference, then the instant application cannot be considered as "unpatentable over Corbau et al. in view of Jones et al."

Further, Applicants respectfully assert that the Examiner bases the current obviousness rejection upon improper picking and choosing of substituents. As provided in MPEP §2144.08, "[t]he claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983); *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1983)."

Applicants further note that this MPEP guidance applies where the claimed species falls within the prior art genus, whereas the current species in the instant application does not even satisfy this criteria (as acknowledged by the Examiner, the instant claim contains an oxygen linker that does not literally fall within the '424 genus).

Moreover, the '424 publication alone does not render the instant claims obvious. As noted by the Examiner, the '424 publication discloses a genus wherein a pyrazole ring is linked to 3,5-dicyanophenyl via a linkage "X", where X is  $-\text{CH}_2-$ ,  $-\text{CHR}-$ ,  $-\text{CO}-$ ,  $-\text{S}-$ ,  $-\text{SO}-$ , or  $-\text{SO}_2-$ . However, the Examiner provides that "the only difference [between the '424 publication and the instant application] is the oxygen rather than a sulfur. ... Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to synthesi[ze] a compound of Formula (I) where 'X' is oxygen and sulfur because the elements have similar properties as they are both in Group VIIA of the Periodic Table." The Examiner further provided that "[t]he teaching of the WO'424 publication together with the instant invention as recited in claims 1, 3, 5, 7 and 19 of the instant application would have motivated one skilled in the art to modify the reagents in the instant application with the teaching of the WO'424 publication in view of the WO'860 publication to make compounds with sulfur and oxygen independently, with the expectation that they would both have the same properties and activity." Applicants respectfully disagree with the Examiner's assertions.

In the case of *In re Grabiak* (769 F.2d 729 (Fed. Cir. 1985)), the Federal Circuit addressed the very question as to alleged obviousness of substituting oxygen for sulfur. In *Grabiak*, "[the prior art] compound differ[ed] from those claimed by Grabiak only by the presence in Grabiak of a sulfur atom instead of a particular oxygen atom in the ester moiety, a difference which the examiner asserted would have been, without more, obvious." (*Id.* at 730). The PTO, in rejecting the *Grabiak* application, had cited a prior art reference as demonstrating the alleged interchangeability of oxygen and sulfur in compounds having herbicidal safener properties (*Id.* at 730).

The Court in *Grabiak*, commenting on whether "a *prima facie* case of obviousness has or has not been made in view of the degree of structural similarity or dissimilarity, or the presence or absence of similar utility between the prior art compound and that of the applicant", noted that "generalization should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other." (*Id.* at 731). Further, the Court cited 1961 CCPA precedent in stating that "[t]he mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination." (*Id.* at 732; internal citation omitted).

Further, the Court noted that the PTO had cited no pertinent reference in suggesting a change from the sulfur-containing group to an oxygen-containing group, and that the Court would not accept the PTO's theory that requires a general assumption that sulfur is not significant to biological behavior. (*Id.* at

732). The PTO had unconvincingly asserted that "it is not 'necessarily true' that safening activity is not predictable from the structure of the compound," and Grabiak's compound themselves purportedly demonstrated such activity, serving as an admission that the Grabiak compounds had the same safening activity as the prior art reference disclosed. *Id.* at 733). The Court rebutted this assertion:

However, Grabiak's disclosure may not be used to fill the gaps in the prior art. If evidence of similar biological properties between -C(O)OR- and -C(O)SR- groups is to be relied upon, it must come from the prior art. The PTO produced no such evidence. Instead, the Board held that "it is not inconceivable to substitute [sulfur for oxygen] to obtain compounds having the same expected properties. We agree that it is not inconceivable. The standard, however, is whether it would have been obvious in terms of section 103. ... In the absence of adequate support, we conclude that this argument does not perfect the PTO's *prima facie* case.

*Id.* at 733 (emphasis added).

Accordingly, the Court held in Grabiak that the PTO did not establish a *prima facie* case of obviousness, and thus the burden did not shift to Grabiak to produce evidence of unexpected results.

Similarly, in *In re Jones* (958 F.2d 347 (Fed. Cir. 1992)), the Federal Circuit Court addressed the question of obviousness in relation to a selection invention where the prior art genus encompassed a potentially infinite genus of substituted ammonium salts, but the claimed species at issue (a specific salt) was not disclosed in the prior art reference. The Court held that the PTO did not establish a *prima facie* case of obviousness, because there was no evidence that one of ordinary skill in the relevant art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed salt (i.e., the selection invention). *Id.* at 351. "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *Id.*, citing *In re Lalu*, 747 F.2d 703, 705 (Fed. Cir. 1984).

Here, the *Grabiak*, *Jones* and *Lalu* cases are instructive. The Examiner in the instant case has asserted that:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to synthesi[ze] a compound of Formula (I) where 'X' is oxygen and sulfur because the elements have similar properties as they are both in Group VIIA of the Periodic Table. ... The teaching of the WO'424 publication together with the instant invention as recited in claims 1, 3, 5, 7 and 19 of the instant application would have motivated one skilled in the art to modify the reagents in the instant application with the teaching of the WO'424 publication in view of the WO'860 publication to make compounds with sulfur and oxygen independently, with the expectation that they would both have the same properties and activity."

Applicants respectfully assert that the Examiner has provided no motivation contained in the prior art for the alleged obviousness of the instant invention, thus a *prima facie* case of obviousness is not sustainable. The '424 publication itself does not contain any reference to X as being oxygen, nor is there

any motivation or discussion within the '424 publication to teach that an oxygen substituent could be substituted for sulfur at position X. Moreover, the biological activity associated with such a change in substituents in the molecule is not readily predictable based on similar individual elements' properties within periodic table groupings alone. The Examiner has indicated that the '860 publication in combination with the '424 publication would provide the motivation, but the '860 publication is not an available § 103 prior art reference against the instant application (as previously discussed). Also, the Examiner has indicated that "the '424 publication together with the instant invention as claimed ... would have motivated one skilled in the art to modify the instant reagents...", and Applicants assert that this alleged motivation cannot stem from Applicants' current application, as it is not available as a prior art reference.

Therefore, Applicants respectfully assert that the rejection of the instant claims under § 103 is improper and request withdrawal of the rejection.


Conclusion

**Based on the above amendments and arguments**, Applicants believe the instant application is in condition for allowance. Early notice of such allowance of the claims is requested.

Please charge any fees that are due in connection with the filing of this response, including any other fee for a required extension of time under 37 CFR 1.136(a), for which Applicants hereby petition, to deposit account 500329.

Respectfully submitted,

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